

Express Mail Label No.
EV619617887US

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT INTERFERENCES

WALTER C. FIERS)
)
v.)
MICHEL REVEL and)
PIERRE TIOLLAIS)
)
v.)
HARUO SUGANO ET AL.)

Interference No. 101,096

New York, New York
November 5, 1984

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

REPLY OF JUNIOR PARTY WALTER C. FIERS TO
SUGANO ET AL.'S OPPOSITION TO FIERS' MOTION
TO AMEND THE ISSUE AND TO BE ACCORDED THE
BENEFIT OF THE FILING DATES OF HIS EARLIER
UNITED KINGDOM PATENT APPLICATIONS WITH
RESPECT TO THE SUBSTITUTED AND ADDED COUNTS

Sir:

Sugano et al.'s opposition to Fiers' motion to amend the issue and to be accorded the benefit of the filing dates of his earlier United Kingdom patent applications with respect to the substituted and added counts ("Sugano Opposition to Fiers Motion to Amend") changes nothing. Sugano does not oppose any part of Fiers' motion to substitute proposed count 2 for Count 1, or, in the alternative, to add proposed count 2 to this Interference. Sugano has ignored the merits of Fiers' motion with respect to proposed counts 3-9.

Accordingly, proposed count 2 should be substituted for Count 1, or added to this Interference, and Fiers should be designated senior party with respect to proposed count 2.

In the interest of judicial economy and fairness, Sugano should be required to demonstrate support for and patentability to him of proposed counts 3-9, or else be estopped from claiming the subject matter of those proposed counts in future ex parte or interference proceedings.

I. SUGANO CONCEDES THAT PROPOSED COUNT 2 SHOULD BE SUBSTITUTED FOR COUNT 1 OR, IN THE ALTERNATIVE, ADDED TO THIS INTERFERENCE

By his silence, Sugano has conceded that proposed count 2 is necessary and preferable to Count 1. See Sugano Opposition To Fiers Motion To Amend, page 1. Sugano also has conceded by his silence that proposed count 2 is patentable to Fiers and supported by Fiers' United States and earlier United Kingdom patent applications.* Therefore, proposed count 2 should be substituted for Count 1, or added to this Interference, and Fiers should be designated senior party with respect to proposed count 2.**

II. FIERS HAS SUSTAINED HIS BURDEN UNDER 37 C.F.R. § 1.231(a)(2) WITH RESPECT TO PROPOSED COUNTS 3-9

Junior party Fiers stated in his Motion To Amend, pages 9-11, the reasons for adding proposed counts 3-9:

* See also Motion Of Junior Party Walter C. Fiers To Amend The Issue By Substitution Of Proposed Count 2 For Count 1 Or By Addition Of Proposed Count 2 And By Addition Of Proposed Counts 3-9 Pursuant To 37 C.F.R. § 1.231(a)(2) And To Be Accorded The Benefit Of The Filing Dates Of His Earlier United Kingdom Patent Applications With Respect To The Substituted And Added Counts Pursuant To 37 C.F.R. § 1.231(a)(4) and (c) ("Fiers Motion To Amend"), pages 5-6, 15-17; Motion Of Junior Party Walter C. Fiers To Be Accorded The Benefit Of The Filing Dates Of His Earlier United Kingdom Patent Applications Pursuant To 37 C.F.R. §§ 1.224 and 1.231(a)(4) And To Shift The Burden Of Proof Under 37 C.F.R. § 1.257(a), pages 9-10.

** Sugano has not shown or even argued that his Japanese applications support proposed count 2.

"Plainly, a single interference should resolve all of the potential priority issues between these applications. Judicial economy demands nothing less. So does the possibility of interference estoppel that may affect junior or losing parties to an interference [citations omitted]." Id. at page 11.

Fiers demonstrated in his motion that proposed counts 3-9 are patentable to him, are supported by his United States and earlier United Kingdom patent applications and are patentably distinct from each other and from Count 1 [id. at 11-13, 15-18].

In his opposition, Sugano never urges that proposed counts 3-9 are not "necessary" to this Interference within the meaning of 37 C.F.R. § 1.231(a)(2). Instead, the sole basis for Sugano's opposition to adding those proposed counts is that Fiers allegedly failed to "demonstrate patentability of the counts to all parties [or] apply the proposed count to all involved applications...." Sugano Opposition To Fiers Motion To Amend, pages 1-2. In this manner, Sugano tries to avoid the merits of the motion, i.e., whether or not Sugano's United States application supports the proposed counts, and whether those counts are patentable to Sugano.*

Sugano's attempt to have Fiers' motion dismissed without addressing its merits should not succeed. Otherwise, Sugano may in the future try to claim priority over the subject matter of proposed counts 3-9, thereby provoking still another interference and postponing again the prosecution and

* Sugano's earlier Japanese applications do not support these proposed counts. See Opposition of Junior Party Walter C. Fiers To Revel and Tiollais' Conditional Motion To Amend The Issue, page 2, 11; Opposition Of Junior Party Walter C. Fiers To The Motion Of Senior Party Sugano Et Al. To Be Accorded For Count 1 The Benefit Of The Filing Dates Of Its Japanese Patent Applications, pages 2-9. Sugano has not tried to demonstrate otherwise.

grant of Fiers' application. Such a result would be wasteful of Patent Office resources and unfair to Fiers. Therefore, Sugano should be compelled to demonstrate any support for proposed counts 3-9 or be estopped in the future from asserting any claim to the subject matter of those counts.

III. CONCLUSION

Proposed count 2 should be substituted for Count 1, or, in the alternative, added to this Interference. And, Fiers should be accorded the benefit of the filing dates of his United Kingdom patent applications and should be designated senior party with respect to that proposed count.

Sugano should be required to demonstrate support for and patentability to himself of proposed counts 3-9. Otherwise, he should be estopped from later asserting a right to the subject matter of those counts.

Respectfully submitted,

Irene J. Frangos
James F. Haley, Jr. (Reg. No. 27,794)
Irene J. Frangos (Reg. No. 31,252)
c/o FISH & NEAVE
875 Third Avenue, 29th Floor
New York, New York 10022
Tel.: (212) 715-0600

Attorneys for Junior Party
Walter C. Fiers

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on December 5, 1984.

Mariet P. Johnston

Name of Person Signing Certificate

Mariet P. Johnston

Signature of Person Signing Certificate

December 5, 1984

Date of Signature

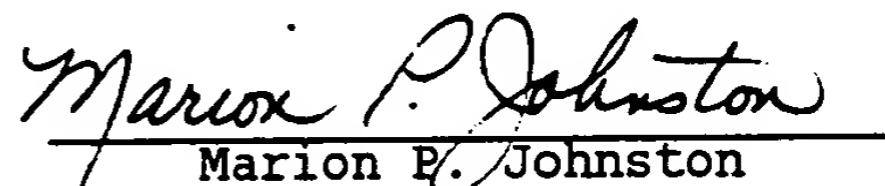
CERTIFICATE OF SERVICE

I, Marion P. Johnston, certify that on the 5th day of November, 1984, I served the attached REPLY OF JUNIOR PARTY WALTER C. FIERS TO SUGANO ET AL.'S OPPOSITION TO FIERS' MOTION TO AMEND THE ISSUE AND TO BE ACCORDED THE BENEFIT OF THE FILING DATES OF HIS EARLIER UNITED KINGDOM PATENT APPLICATIONS WITH RESPECT TO THE SUBSTITUTED AND ADDED COUNTS on party Sugano et al., and on party Revel and Tiollais, by causing one true copy of the same to be deposited with the United States Postal Service, first class, postage prepaid, addressed, respectively, to counsel for Sugano et al.:

Joseph M. Fitzpatrick, Esq.
Nels T. Lippert, Esq.
Fitzpatrick, Cella, Harper & Scinto
277 Park Avenue
New York, New York 10172

and to counsel for Revel and Tiollais:

Alvin Browdy, Esq.
Roger L. Browdy, Esq.
Browdy and Neimark
419 7th Street, N.W.
Washington, D.C. 20004.


Marion P. Johnston

Marion P. Johnston